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PATENT LAW

SARKISIAN V. WINN PROOF CORPORATION: WHEN THE RESULT IS A SURPRISE, TWO PLUS TWO MUST EQUAL FIVE

A. INTRODUCTION:

The Ninth Circuit and other circuits have wrestled with the meaning of “synergism” as it applies to the patentability of combination patents.¹ The circuits have not agreed as to the proper standard for synergism,² resulting in inconsistent adjudication of patents throughout the circuits. In *Sarkisian v. Winn Proof Corporation*,³ the Ninth Circuit, sitting *en banc*, held that the “unusual or surprising results” test is the sole and exclusive measure of patentability for combination patents.⁴

FACTS OF THE CASE

In 1970, Sarkisian filed a patent for a lightweight, portable sign stand with a virtually weightless base.⁵ Sarkisian’s stand could withstand wind conditions of up to 80 m.p.h. without “walking” or tipping over, and would deflect away from the line

1. Republic Industries Inc. v. Schlage Lock Co., 592 F.2d 963, 969 (7th Cir. 1979). See also Gettleman Mfg., Inc. v. Lawn “N” Sport, 517 F.2d 1194, 1199 (7th Cir. 1975) (the elements must take on a surprising quality); E-T Industries, Inc. v. Whittaker Corp., 523 F.2d 636, 641 (7th Cir. 1975), *cert. denied*, 429 U.S. 870 (1976) (the combination must produce a result other than the anticipated sum of the separate parts); Panduit Corp. v. Burndy Corp., 517 F.2d 535, 539 (7th Cir.), *cert. denied*, 423 U.S. 987 (1975) (the elements must, in the aggregate, produce new, unusual or striking results); Reese v. Elkhart Welding & Boiler Works, Inc., 447 F.2d 517, 526 (7th Cir. 1971) (the results must be unachieved by prior art structures).

2. Rengo Co. Ltd. v. Molins Mach. Co., 657 F.2d 535 (3d Cir.), *cert. denied*, 454 U.S. 1055 (1981).

3. Sarkisian v. Winn-Proof Corp., 697 F.2d 1313 (9th Cir. 1983) (per Alarcon, J., Canby, J., and Hoffman, D.J.) *aff’g*, 688 F.2d 647 (1982).

4. 688 F.2d at 650.

5. Testimony indicated that existing sign stands were made with bases of no less than 75 lbs. 697 F.2d at 1319. The stands had to be weighted down with 200 to 300 lbs. to avoid tipping over during high winds. *Id.* at 1320.

of traffic when struck by a vehicle.⁶ This unusual stability resulted from the use of "pre-loaded" springs to connect the sign with its base.⁷

While the first patent was pending,⁸ Sarkisian filed a second patent application⁹ which extended the coverage of the original patent's monopoly.¹⁰ Along with the second application, Sarkisian filed a terminal disclaimer,¹¹ which waived his right to an extension of the seventeen-year monopoly granted by the first patent.

In 1975, defendant William Werner developed a spring mounted sign stand designed to hold large display boards. Most of the stands were sold without the display boards. Although Werner's sign stand differed in appearance from Sarkisian's sign stand,¹² it utilized the same operating principle of "loaded springs" which Sarkisian had developed.¹³

Subsequently, Sarkisian filed an action¹⁴ claiming the distri-

6. *Id.* at 1319.

7. *Id.* at 1315.

8. An issued patent grants to the patentee a seventeen-year period in which other persons are estopped from producing, using or selling his patented device without first gaining the patentee's permission. *Id.* at 1324.

9. The claims in the second patent were broader than the claims in the first patent. *Id.* The spring mechanism in the second patent is claimed as a pair of "spring means", rather than as a pair of "coil springs" in compression, as in the first patent. *Id.* Also, the legs of the second patent are described simply as "ground engaging means", eliminating the limitation of "generally parallel legs claimed" in the first patent. *Id.*

10. After the first application is granted, the original patent's seventeen-year monopoly is impermissibly extended until the second patent expires, denying the public its statutory right to use the invention at the end of the first monopoly period. *Id.*

11. Terminal disclaimers are submitted pursuant to 35 U.S.C. § 253 (1952) to overcome double patenting problems. The purpose of the terminal disclaimer is to terminate that portion of the second application which would otherwise extend beyond the expiration date of the first patent. *Id.*

12. Although Werner's sign stands were designed to hold large display boards, they were sold, for the most part, without display boards. 697 F.2d at 1316.

13. These spaced-apart springs, i.e., springs not located on the same vertical axis, were sufficiently rigid to hold the display board in an upright position during ordinary conditions. *Id.* at 1315. The "initial" or "pre-loaded" degree of the compression of the springs, measured by the amount of force required to separate their coils, was set in relation to the length and weight of the bases, the location of the sign stand's center of gravity, and the dimensions and weight of the display board. *Id.* This precise spring compression enabled Sarkisian's lightweight based stand to remain upright during high winds. *Id.*

14. The action was filed against defendants Winn-Proof, William Werner and Wernel Enterprises. *Id.*

bution of the Werner device constituted a patent infringement. Defendants contended there was no infringement, as both patents were invalid; the first for failure to meet the requirements of 35 U.S.C. § 103¹⁵ for nonobviousness, the second for double patenting. The trial court held that the first patent was valid and infringed, but the second patent was invalid for double patenting.

On appeal, a Ninth Circuit panel affirmed the validity and infringement of the first patent, holding that the patent was nonobvious.¹⁶ The panel reversed as to the double patenting and found infringement of the second patent as well.¹⁷ Following consolidation with two other cases,¹⁸ the Ninth Circuit ordered a rehearing *en banc*.¹⁹

B. BACKGROUND:

The Patent Act of 1793 provided that if any new invention was to be patented, it had to be both new and useful.²⁰ As inventions using old elements began to appear, the courts became hesitant to uphold patents for inventions that were similar to prior inventions.²¹

The Supreme Court in *Great Atlantic & Pacific Tea Co. v.*

15. Section 103 provides in relevant part:

A patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

35 U.S.C. § 103.

16. 686 F.2d 671 (9th Cir. 1981).

17. *Id.* at 689.

18. *Carson Mfg. Co. Inc. v. Carsonite International Corp. Inc.*, 658 F.2d 1306 (9th Cir. 1981); *Hammerquist v. Clarke's Sheet Metal, Inc.*, 658 F.2d 1319 (9th Cir. 1981).

19. The *en banc* panel held that if a combination patent (a patent for a device containing old elements which produce a new result) is to be nonobvious, it must produce an unusual or surprising result. 688 F.2d at 651. On remand, the three-judge panel held that plaintiff's first patent was valid as it did produce an unusual or surprising result and that the second patent was valid as there had been no double patenting. 697 F.2d at 1313. Further, that defendants were liable for patent infringement of both patents. *Id.* at 1323 n.22.

20. 592 F.2d at 967.

21. *Hotchkiss v. Greenwood*, 52 U.S. (11 How.) 248 (1851); *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147 (1950).

Supermarket Equipment Corp.,²² for the first time defined the standard applicable for determining the validity of a combination patent. In reviewing the patentability of a three-sided rack,²³ the Court noted that the key to patentability is the presence or lack of invention,²⁴ but added that this standard becomes inherently elusive when applied to a combination of old elements.²⁵ The Supreme Court explained that the test for combination patents turns on whether the whole device in some way exceeds the sum of its parts; if it does, the accumulation of devices using old parts is patentable.²⁶ The Court reversed the lower court's finding of patentability,²⁷ concluding that plaintiff's device did not meet the appropriate standard for it exhibited no unusual or surprising consequences from the unification of old elements. Further, the Supreme Court directed that the lower courts should scrutinize combination patent claims with a standard of care proportionate to the difficulty and improbability of finding invention in an assembly of old elements.²⁸

Prior to the revision of the patent laws in 1952,²⁹ only novelty and utility were used in determining the patentability of an invention.³⁰ The 1952 revision additionally required nonobviousness as a condition of patentability.³¹ In subsequent years there was confusion in the federal courts in determining the nonobvi-

22. 340 U.S. at 150.

23. The rack was designed to draw or push goods placed within it on a grocery counter from one place to another. *Id.* at 152.

24. *Id.* at 151.

25. In citing prior Supreme Court cases, the Court stated that the accumulation of old devices is patentable only when the whole in some way exceeds the sum of its parts. The Court was concerned that a mere aggregation of known elements would not produce a new or different function. The Court noted that except in chemistry, this standard was difficult to attain. *Id.* at 151-52.

26. *Id.*

27. *Id.* at 152.

28. *Id.*

29. Patent Act of 1952, ch. 950, 66 Stat. 798 (codified as amended at 35 U.S.C. § 101-99 (1952)).

30. Patent Act of 1793, ch. XI, § 1, 1 Stat. 318.

31. Patent Act of 1952, ch. 950, 66 Stat. 798. Section 103 states that:

a patent may not be obtained if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art. . . .

35 U.S.C. § 103.

ousness required by section 103.³²

In *Graham v. John Deere Co.*,³³ section 103 finally received a definitive interpretation by the Supreme Court.³⁴ The Court in *Graham* recognized that section 103 was only one of three conditions which had to be satisfied for patentability, and that when determining whether a patent was nonobvious, the court must make three factual inquiries: (1) the scope and content of the prior art; (2) differences between the prior art and the claims at issue; and (3) the level of ordinary skill in the pertinent art.³⁵

The Supreme Court first applied the *Graham* analysis in determining the validity of a combination patent in *Anderson's-Black Rock v. Pavement Co.*³⁶ The Court, rejecting a combination patent for a bituminous paving machine which combined a radiant heat burner and an asphalt shaper apparatus, emphasized the importance of strictly adhering to the requirements set forth in *Graham*.³⁷ The Court reasoned that the combination of putting the burner together with the other elements in one machine, though perhaps a matter of great convenience, did not produce a "new or different function"; therefore, the combination was not an invention under the nonobviousness standard.³⁸

32. In *Technical Tape Corp. v. Minn. Mining & Mfg. Co.*, 247 F.2d 343 (2d Cir. 1957), *cert. denied*, 355 U.S. 952 (1958), the court said, "A novel combination of old elements which cooperate with each other so as to produce a new and useful result is patentable." *Id.* at 347; *accord* *Weller Mfg. Co. v. Wen Products, Inc.*, 231 F.2d 795, 798 (7th Cir. 1956). *See also* *Brown v. Brock*, 240 F.2d 723, 727 (4th Cir. 1957) ("The contention of obviousness is . . . conceived *after* the event . . . 'obviousness' is often much clearer after the event than before. . . ."); *Jeoffroy Mfg. Inc. v. Graham*, 219 F.2d 511 (5th Cir. 1955) *cert. denied*, 350 U.S. 926 (1955) ("An improvement combination is patentable even though its constituent elements are singly revealed by the prior art where . . . it produces a useful result in a cheaper and otherwise more advantageous way."); *Reiner v. I. Leon Co.*, 285 F.2d 501, 503 (2d Cir. 1960), *cert. denied*, 366 U.S. 929 (1961) ("The test laid down is indeed misty enough. It directs us to surmise what was the range of ingenuity of a person 'having ordinary skill' in an 'art' with which we are totally unfamiliar. . . ."); *Copease Mfg. Co. v. Amn. Photocopy Equipment Co.*, 298 F.2d 772 (7th Cir. 1961); *Int'l Mfg. Co. v. Landon, Inc.*, 336 F.2d 723 (9th Cir. 1964), *cert. denied*, *Jacuzzi Bros., Inc. v. Landon, Inc.*, 379 U.S. 988 (1965); *McCullough Tool co. v. Well Surveys, Inc.*, 343 F.2d 381 (10th Cir. 1965), *cert denied*, 383 U.S. 933 (1966).

33. 383 U.S. 1 (1966).

34. 592 F.2d at 968.

35. 383 U.S. at 17.

36. 396 U.S. 57 (1969).

37. *Id.* at 62.

38. *Id.* at 63.

In *Sakraida v. Ag Pro, Inc.*,³⁹ the Supreme Court reaffirmed the *Graham* test for patentability of a combination patent.⁴⁰ The Court considered the scope and content of the prior art together with the differences between the art and the claimed invention.⁴¹ The Court reversed the lower court's finding of patentability and stated that the patent had failed the synergism test.⁴²

Ninth Circuit:

In *Penn Int'l Industries v. Pennington Corp.*,⁴³ the Ninth Circuit reviewed the patentability of a waterbed in light of its obviousness as compared to previously manufactured waterbeds. The Ninth Circuit for the first time explained that a combination patent had to demonstrate an "unusual or surprising result" to warrant patentability under the nonobviousness standard.⁴⁴

In *Palmer v. Orthokinetics, Inc.*,⁴⁵ the Ninth Circuit reviewed the patentability of a "travel chair", which simplified the process of moving a wheel chair bound person in and out of an automobile. The lower court held that since the chair's function was neither unexpected nor nonobvious, it failed the synergism test.⁴⁶ The appellant argued that the court incorrectly applied the synergism test in determining patent validity. Without re-

39. 425 U.S. 273 (1975).

40. *Id.* at 280.

41. The patent was for a device that used a combination of old elements to produce an abrupt release of water directly onto a barn floor from storage pools or tanks to remove animal waste. *Id.* at 275-77.

42. The Supreme Court stated that plaintiff's patent simply arranged old elements of a flushing system, with each element performing the same function it had been known to perform in the past. *Id.* at 282. The old elements delivered water directly rather than through pipes or hoses to the barn floor. *Id.* The Court explained that although the device was a faster, cheaper and more convenient way to flush barns, it did not warrant patentability as it had not produced a new or different function. *Id.*

43. 583 F.2d 1078 (9th Cir. 1978).

44. *Id.* at 1082. The Ninth Circuit continued to require an unusual or surprising result to establish the validity of a combination patent in *Herschensohn v. Hoffman*, 593 F.2d 893 (9th Cir.), *cert. denied*, 444 U.S. 842 (1979). In *Herschensohn* the court reviewed the validity of a patent for a hairbrush. The brush contained a flexible spine coupled with "bristle carrying fingers" which extended laterally on each side of the spine. *Id.* at 896. Plaintiffs contended that the spine and the vents between the "finger members" allowed the brush to be pulled through the hair with ease and that this was an unusual or surprising result. *Id.* The Ninth Circuit disagreed and reversed the district court's finding of a valid patent. *Id.*

45. 611 F.2d 316 (9th Cir. 1980).

46. *Id.* at 318.

jecting the synergism test, the Ninth Circuit reversed the district court's finding and remanded the matter for further consideration and determination of nonobviousness under *Graham*.⁴⁷

In 1982, the Ninth Circuit considered the patentability of two combination patents.⁴⁸ The court held that if a combination patent were to satisfy the nonobviousness standard in *Graham*, it must pass the synergism test and result in new and unexpected characteristics at the time of manufacture.⁴⁹

Recently, in *Rite-Nail Packaging Corp. v. Berryfast, Inc.*,⁵⁰ the Ninth Circuit reviewed the patentability of a carrier wheel which fed articles into a machine to be encapsulated by plastic. The court found the patent invalid on the grounds that it was a combination patent which did not produce a new and surprising or unusual result.⁵¹

Other Circuits:

The Seventh Circuit in *Republic Industries Inc. v. Schlage Lock Co.*⁵² was the first of the three circuits to reject synergism.⁵³ The *Republic* court reasoned that the term synergism was misused, noting that most mechanical devices consist of parts which interact with each other; therefore, the presence or absence of synergism proved little.⁵⁴ In contrast to the focus on the after effects under the synergism approach, section 103 provides that the standard of patentability is the nonobviousness of an invention "at the time the invention was made. . . ."⁵⁵ The court further noted that since synergism focused exclusively on the performance of the elements after they were combined and without regard to the obviousness or nonobviousness of making the combination, synergism did not comport with the *Graham*

47. *Id.* at 323-25.

48. *Smith Int'l Inc. v. Hughes Tool Co.*, 664 F.2d 1373 (9th Cir. 1982), *cert. denied*, 456 U.S. 976 (1982); *Omark Indus. Inc. v. Textron, Inc.*, 688 F.2d 1242 (9th Cir. 1982).

49. 664 F.2d at 1376; 688 F.2d at 1249.

50. 706 F.2d 933 (9th Cir. 1983).

51. *Id.* at 935.

52. 592 F.2d 963.

53. The *Republic* court viewed synergism as only a figure of speech since no result is actually greater than the sum of its parts. *Id.* at 970.

54. *Id.*

55. *Id.* at 971.

mandate to apply section 103.⁵⁶ The court stated that since section 103 applied to all patent claims, there was no justification for measuring the patentability of a combination patent by a different standard than other inventions.⁵⁷ The Tenth and Third Circuits have also rejected synergism.⁵⁸

Other circuit courts have refrained from using synergism and have continued to apply the *Graham* factual analysis.⁵⁹

Double Patenting

In determining double patenting questions, the Court of Customs and Patent Appeals has set forth a two-step process to be used by the courts.⁶⁰ If one of the claims can be literally infringed without literally infringing the other, then the claims are not the same and the focus shifts to whether one claim is an obvious variation of the other. If no obvious variations exist, then there has been no double patenting.⁶¹

C. ANALYSIS BY THE COURT:

The *en banc* panel, in reviewing the meaning of the term synergism noted that the Supreme Court has yet to define the term.⁶² The court stated that a close reading of previous Ninth Circuit holdings reveals that synergism has always been the functional equivalent of the "unusual or surprising results" test

56. *Id.*

57. *Id.*

58. In *Plastic Container Corp. v. Continental Plastics*, 607 F.2d 885 (10th Cir. 1979), *cert. denied*, 444 U.S. 1018 (1980), the Tenth Circuit followed the Seventh Circuit's rejection of "synergism." *Id.* at 904-05. The Tenth Circuit now applies the *Graham* test only to decide patentability of all patents. See, e.g., *Escoa Fintube Corp. v. Tranter, Inc.*, 631 F.2d 682, 696 (10th Cir. 1980) (wherein the Tenth Circuit held a patent for a serrated fin heat exchange and for a method of continuously welding segmented fin stock to a cylindrical tube by high frequency resistance method was obvious in view of the prior art and therefore there had been no infringement of plaintiff's patent); *Rengo Co. Ltd. v. Molins Mach. Co.*, 657 F.2d 535, 546 (3d Cir. 1981) *cert. denied*, 454 U.S. 1055 (1981) (where the Third Circuit reviewed the validity of a patent for a corrugator, a machine that manufactured 3-ply paperboard from which familiar cardboard boxes are made, and held that the *Graham* test was the proper test to be applied to all patents).

59. See *Whitley v. Road Corp.*, 624 F.2d 698 (5th Cir. 1980); *Square Liner 360° Inc. v. Chisum*, 691 F.2d 362 (8th Cir. 1982); *Smith v. ACME General Corp.*, 614 F.2d 1086 (6th Cir. 1980); *In re Kollman*, 595 F.2d 48 (1979).

60. *Application of Vogel*, 422 F.2d 438 (9th Cir. 1970).

61. If an obvious variation exists, a terminal disclaimer is required to prevent an extension of the seventeen-year monopoly granted by a patent. *Id.* at 441-42.

62. 688 F.2d at 649.

for assessing nonobviousness under 35 U.S.C. § 103.⁶³ In recognizing a need for precision and consistency, the court held that the unusual or surprising results test is the sole and exclusive measure of patentability for combination patents in the Ninth Circuit.⁶⁴

In applying the test, the *en banc* panel reviewed the withdrawn decision in *Sarkisian*⁶⁵ and concluded that the three-judge panel had disavowed the test established in *Great Atlantic* requiring unusual or surprising results for patentability of combination patents.⁶⁶ The court stated that the lower court's analysis was unacceptable in that it would lower the standard of patentability for combination patents.⁶⁷

The *en banc* panel remanded *Sarkisian* to the three-judge panel for a determination of whether the sign stand produced an unusual or surprising result. The court explained that by reaffirming the unusual or surprising results test, it was complying with the constitutional standard set out in *Graham* and embodied in section 103.⁶⁸

On remand, the three-judge panel upheld the validity of plaintiff's device. It was nonobvious, the panel noted, since it clearly met the "unusual or surprising results" test.⁶⁹ The panel discussed in detail the functions of each of the elements in plaintiff's stand.⁷⁰ To further strengthen this determination, the

63. *Id.*

64. *Id.* at 650.

65. 686 F.2d 671.

66. 688 F.2d at 650.

67. *Id.*

68. The court stated that "obviousness" is a term of art and the unusual or surprising results formulation merely clarifies the obviousness standard. *Id.* The test also expressed the need to exercise caution in determining patentability of combination patents. *Id.*

69. 697 F.2d at 1318.

70. The panel acknowledged the similarity between the "spaced apart" legs on plaintiff's device and those used in a Thompson base but noted that the function of the legs on plaintiff's sign stand was to withstand an impinging force, making the sign wind proof. *Id.* There was no evidence that Thompson's sign stand possessed this characteristic. *Id.* The panel next considered the function of the "spaced apart" springs and found that they controlled the direction of the sign stand away from the line of traffic when struck by a vehicle. *Id.* at 1319. No other sign stand could perform in a similar manner. *Id.* The lightweight base on plaintiff's stand provided surprising stability. *Id.* at 1320. All other bases on other sign stands required a minimum of 75 lbs. each to maintain the

panel also considered the "secondary" indicia of nonobviousness as outlined by the Supreme Court in *Graham*.⁷¹

The panel next considered whether defendants' stand was an infringement of plaintiff's patent. To decide infringement the panel applied the doctrine of equivalents.⁷² The purpose of this doctrine, according to the panel, was to reward the inventor for his or her invention; therefore, patents which represent important and significant advances in relevant technology would be entitled to a broader range of equivalents than those patents which represent a rather small advance in a crowded field.⁷³ The panel agreed with the district court that plaintiff's device was entitled to a broad range of equivalents in that it represented a significant advance in the field of unanchored, readily portable, windproof sign stands.⁷⁴ The panel affirmed the district court's determination that the differences between defendants' signs and plaintiff's patent were insignificant and the devices were the equivalents of the device claimed in the first patent,⁷⁵ thereby constituting patent infringement.⁷⁶

The panel compared the plaintiff's two patents and found that there had been no double patenting.⁷⁷ Accordingly, the

same stability. *Id.*

71. These considerations are (1) the commercial success of the device and (2) long felt but unsolved needs and prior unsuccessful attempts to solve the problem ultimately addressed by the new invention. 383 U.S. at 17-18. The panel found that the evidence of record fully supported the lower court's findings that (1) plaintiff's sign had enjoyed substantial commercial success, (2) plaintiff's sign had solved the longstanding problem of "walking" and tipping over in high winds, and (3) other companies had been unsuccessful in their efforts to produce a "readily portable" road sign. 697 F.2d at 1320.

72. Under this test, two devices are considered to be the same if they do substantially the same work in substantially the same manner, and accomplish substantially the same results. *Id.* at 1321 (quoting *Union Paper Bag Machine Co. v. Murphy*, 97 U.S. 120, 125 (1878)).

73. 697 F.2d at 1322.

74. *Id.* at 1320.

75. *Id.*

76. The court reasoned that although defendant Werner's stands were generally sold without signs, they were specifically designed to hold signs, and therefore, resembled plaintiff's invention. *Id.* at 1323.

77. The panel expressed an awareness that "double patenting" is a difficult area of patent law. *Id.* at 1324. Applying the *Vogel* test, the panel found that although the two patents overlapped, they were not the same. *Id.* at 1326. Rather, obvious variation double patenting was involved. *Id.* The panel noted that the Ninth Circuit has previously indicated that "obviousness" type double patenting does not automatically void subsequent patent applications if the later application will not extend the original patent's monopoly. *Id.*

panel reversed the district court's finding of validity of both patents.⁷⁸

D. CRITIQUE:

The Ninth Circuit in *Sarkisian* held that a determination of an unusual or surprising result (synergism) is necessary for a finding of nonobviousness of a combination patent. By using the synergism test as the means of assessing nonobviousness under 35 U.S.C. section 103, the Ninth Circuit imposes a stricter standard than required by the Supreme Court in *Graham*. Considering that the Supreme Court admonished lower courts to strictly adhere to the *Graham* test, this standard is inappropriate. Moreover, the Ninth Circuit action was unnecessary. The *Graham* standard is totally adequate for determining obviousness under section 103. It is immaterial that *Sarkisian* involved a combination patent. The statute makes no distinction and the Supreme Court had no difficulty applying the *Graham* analysis to a combination patent.⁷⁹

Finally, the synergism test is unworkable. By applying synergism, the Ninth Circuit overlooked two major flaws in the synergism approach. First, the synergism approach is based on the assumption that it is always obvious to take known elements and combine them,⁸⁰ discounting that the selection of the elements themselves may be nonobvious and inasmuch inventive.⁸¹ Accordingly, bona fide inventions displaying such nonobvious selection would be excluded from being patented.

The second flaw in the synergism approach is that it overlooks the fact that in mechanical patents, it is only a remote possibility that constituent parts which perform known and expected functions would function differently when combined so that an unusual result would be produced.⁸² Thus, in theory,

78. *Id.* The panel concluded there had been no double patenting as the terminal disclaimer filed by plaintiff eliminated any danger of extending the monopoly. *Id.*

79. 396 U.S. at 62.

80. 592 F.2d at 971.

81. *Id.*

82. 657 F.2d at 545. As Judge Learned Hand noted:

All machines are made up of the same elements: rods, pawls, pitmans, journals, toggles, gears, cams, and the like, all acting their parts as they always do and always must. . . But the elements are capable of an infinity of permutations and the selec-

mechanical patents would rarely be upheld; in practice the standard becomes subjective, depending primarily upon the judge's degree of surprise. While synergism or unusual or surprising results may indicate nonobviousness, the absence of it should play no role in evaluating obviousness under 35 U.S.C. Section 103.

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tion of that group which proves serviceable to a given need may require a high degree of originality. *It is that act which is the invention.* . . .

Id. (citing *B. G. Corp. v. Walter Kidde & Co.*, 79 F.2d 20, 22 (2d Cir. 1935) (emphasis added)).

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